

### REMARKS/ARGUMENTS

The present application has been carefully reviewed in light of the February 7, 2003 Office Action. In light of the foregoing amendments, and the following remarks, Applicant respectfully requests reexamination and reconsideration of the application.

### TIME EXTENSION

Submitted herewith is a Three-month time extension request and appropriate fee.

### DRAWINGS

Apparently the original filed drawings (photographs) were destroyed due to irradiation. Thus, at the suggestion of the Examiner, Applicant has submitted substitute drawings (photographs) to the P.O. Box 2327, Arlington, Virginia 22202 address. Applicant has also included drawings directed to the fruit of the instant variety per the requirement of the Examiner.

### OBJECTION TO THE DISCLOSURE

Applicant has amended the application on a point-by-point basis of paragraphs A-R of the Office Action. Applicant has provided color photographs, including illustration of the fruit flesh and stone of the instant cultivar. Applicant has included a Botanical Classification heading, corrected various grammatical errors, and included as much information as is possible with respect to the requests in the remaining paragraphs. With these amendments, Applicant believes that the objection is overcome. Applicant further reminds the Examiner that the requirements of 35 U.S.C. are limited in plant applications. As stated in 35 U.S.C. §162, no plant patent shall be declared invalid for non-compliance with

§112 of this title if the description is as complete as is reasonably possible. Applicant has included as much information as is reasonably possible, and even provided additional information per the request of the Examiner. Thus, Applicant respectfully asserts that the disclosure is in proper condition and meets the requirements of 35 U.S.C. §112.

The Examiner in paragraph E of the Office Action referred to §1612 of the Manual of Patenting Examining Procedure and addressed the confusion regarding the 'Dusa' and 'Merensky 2' cultivar names in previous South African Plant Breeder's Right Certificates. Applicant's attorney refers to the attached Declaration of Dr. Josef Stefan Köhne, wherein Dr. Köhne explains this discrepancy, and the need to change the name in the Plant Breeder's Right Certificates due to trademarking purposes. The current and most updated version of the South African Plant Breeder's Right Certificate is labeled 'Merensky 2'. Applicant believes that Dr. Köhne's explanation, as well as the fact that the most recent Plant Breeder's Right Certificate and the present patent application use the same name to identify the cultivar eliminates any potential confusion.

#### CLAIM REJECTIONS UNDER 35 U.S.C. §102 AND §103

The Examiner rejected claim 1 under 35 U.S.C. §102(b) as being anticipated based on the erroneous assertion that the instant cultivar is genetically identical to 'Edranol', 'Ettinger', or 'Fuerte'. However, as noted by Dr. Köhne in his Declaration, it appears as if the Examiner has misread the paragraph in question in the Background of the Invention section of the present patent application. This paragraph indicates that leaves from five root stock selections, including the instant cultivar 'Merensky 2', were used. Three samples from each cultivar were tested. No variation could be found between the different samples from the same cultivar. That is to say that the leaves from the same cultivar were genetically identical, which should be the case as the leaves were taken from the same cultivar tree. It was also concluded that two of the cultivars were genetically identical. "However, there were differences found between the 'Merensky

2' and the other varieties". Dr. Köhne further declares that the instant cultivar is genetically different than any other known variety which has been tested. Accordingly, Applicant respectfully requests that the Examiner withdraw this rejection.

Claim 1, and thus the present application, was also rejected under 35 U.S.C. §102 based on the assertion that various printed publications serve as a statutory bar under 35 U.S.C. §102(b) as they enable one of ordinary skill in the art to reproduce the claimed plant. The Examiner further refers to a publication disclosing a "semi-commercial" "Hass" planting at Westfalia Estate. Thus, the Examiner asserts that the plant was publicly available more than one year prior to the filing date of the instant U.S. application.

Applicant respectfully traverses this rejection. Dr. Köhne in his attached Declaration, has explained the various phases of experimental testing which have been performed on the instant cultivar. The "experimental testing" phase one entails a limited number of plants which are grown on the owner's farms and monitored by the owner's research personnel. The second experimental phase, "semi-commercial" entails expanding the number of trees and areas. This has occurred on both the owner's property under the owner's research personnel's direction and on other plots of land, namely, that owned by the University of California/Riverside under non-propagation agreements. As explained by Dr. Köhne, the University of California/Riverside is involved for educational testing purposes only. Such arrangements were initially formed by oral agreement, and subsequently embodied in a written non-propagation and bailment agreement. As Dr. Köhne indicated, the instant cultivar was not available to any outside person, skilled or otherwise, and closely guarded and thus the publication cited, including the South African Plant Breeder's Right, does not enable any skilled artisan to attain, make or reproduce the instant cultivar.

The 1962 landmark case of *In re LeGrice*, 133 USPQ 365 (CCPA 1962), held that a printed publication cannot bar patentability of a plant variety if the printed publication does not enable the invention. See

also, [*Exparte Thomson*, 24 USPQ 2d 1618 (BPAI 1992), and *Imazio Nursery, Inc. v. Dania Greenhouses*, 69 F. 3d 156 (Fed. Cir. 1995)].

It is well known, and as indicated by Dr. Köhne, that no printed publication is enabling with respect to a plant variety. In the case of the instant cultivar, access to the plant itself must be had in order to reproduce the variety. As the present cultivar was not publicly available anywhere in the world more than one year prior to the filing date of the present application, no one other than the owner of the instant cultivar and those under strict testing and non-propagation agreements had access to the plant. Thus, the plant was not in public use or on sale in this country, or any other, more than one year prior to the date of the application for patent in the United States of America. The publications, including the South African Plant Breeder's Rights, cited in the Office Action are simply not enabling. Absent public access to the plant itself, those of ordinary skill, or of any level of skill, in the art would not be able to reproduce the claimed plant.

In light of Dr. Köhne's explanation that the phrase "semi-commercial" as used with respect to the experimental testing of the present cultivar, and the confirmation that the plant of the present application has not been publicly available or for sale for more than one year prior to the filing of the present application, Applicant respectfully requests that the Examiner withdraw the §102 rejection as it is improper.

## CONCLUSION

From the foregoing amendments and remarks, Applicant believes that the present application is in condition for allowance, notice of which is hereby respectfully requested.

Respectfully submitted,

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Enclosure